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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,083	02/25/2004	Hajime Maki	Q79995	8545

23373 7590 11/16/2005

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EXAMINER	
SAMPLE, DAVID R	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/785,083	MAKI ET AL.	
	Examiner	Art Unit	
	David Sample	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE / MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20050919;20040729*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al. (US Patent Publication 2002/0187097).

Uchida et al. discloses a method of making an α-alumina powder by calcining a mixture of an alumina precursor and a seed material. See page 3, Example 5. Example 5 contains 30 wt% seed, and, by subtraction, 70 wt% alumina precursor. Thus, example 5 anticipates step (II) of claim 1 and claim 11.

Claims 2-9 are rejected because they do not apply when step (II) is selected in claim 1.

Example 5 employs aluminum hydroxide as the aluminum precursor, which anticipates claim 10.

Example 5 employs titanium oxide as a see, which anticipates claim 12.

Example 5 calcines at 870°C which anticipates claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US Patent Publication No. 2002/0187097 as applied to claims 1 and 11 above, and further in view of the teachings of the reference.

As noted above, Example 5 of Uchida et al. anticipate claim 1 and 11. The anticipatory example does not contain one of the species recited in claim 13. However, Uchida et al. discloses that the seed material is preferably an oxide of iron, titanium, or chromium. See paragraphs [0015] and [0016].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted iron or chromium oxide for the titanium oxide of Example 5 because the reference discloses that such compounds are useful seeding materials.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Kajihara et al. (US Patent Publication number 2004/0131856).

Kajihara et al. discloses a method of making an α-alumina powder in which a mixture of an alumina precursor and seed is calcined. See paragraph [0017]. The seed is added in an amount of 0.1 to 30 wt%. See paragraph [0022]. This amount of seed overlaps the amount recited in instant claim 1, step II, and claim 11. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The reference does not explicitly disclose the amount of alumina precursor present the mixture that is calcined. However, by subtraction, if the reference discloses incorporating 0.1-30 wt% seeds based upon the total amount of alumina, the alumina must be contained in an amount of 99.9-70 wt%.

Claims 2-9 of the instant application are rejected because they do not apply when step (II) is selected in claim 1.

The recitations of instant claim 10 can be found in paragraph [0019] of the Kajihara et al.

The recitations of instant claims 12 and 13 can be found paragraph [0022] of Kajihara et al.

The recitations of instant claim 14 can be found in the reference in paragraph [0026].

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome

by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Double Patenting

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-15 of copending Application No. 10/671,727 ('727) published as US 2004/0131856. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference discloses overlapping ranges of seed and alumina precursor content (claim 14) with the amount recited in claims 1 part (II) and claim 11.

Claims 2-9 of the instant application are rejected because they do not apply when step (II) is selected in claim 1.

The recitations of instant claim 10 can be found in claims 6 and 7 of the '727 application

The recitations of instant claims 12 and 13 can be found in claims 11 and 12 of the '727 application.

The recitations of instant claim 14 are rendered obvious by the reference because it would have been obvious to one of ordinary skill in the art to have employed any calcination temperature including the claimed temperature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/846,693 ('693) published as US 2005/0008565. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference discloses overlapping ranges of seed and alumina precursor content (claim 8) with the amount recited in claims 1 part (II) and claim 11.

Claims 2-9 of the instant application are rejected because they do not apply when step (II) is selected in claim 1.

The recitations of instant claim 10 can be found in claims 2 and 3 of the '693 application

The recitations of instant claims 12 and 13 can be found in claims 5-7 of the '693 application.

The recitations of instant claim 14 can be found in claim 10 the '693 application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-11 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 11/076,836 ('836) published as US 2005/0201928. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference discloses overlapping ranges of seed and alumina precursor content (claims 10 & 11) with the amount recited in instant claims 1 part (II) and claim 11.

Claims 2-9 of the instant application are rejected because they do not apply when step (II) is selected in claim 1.

The recitations of instant claim 10 can be found in claims 2 and 3 of the '836 application

The recitations of instant claim 14 can be found in claim 12 the '836 application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

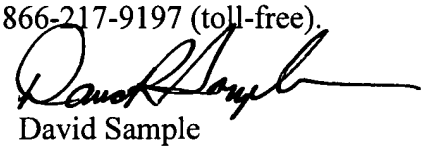
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (571)272-1376. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (572)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Sample
Primary Examiner
Art Unit 1755